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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/772,813

02/05/2004

Kim D. Gooding

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CIBA SPECIALTY CHEMICALS CORPORATION
PATENT DEPARTMENT
540 WHITE PLAINS RD
P O BOX 2005
TARRYTOWN, NY 10591-9005

EXAMINER

SANDERS, KRIELLION ANTIONETTE

ART UNIT

PAPER NUMBER

1714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/772,813	Applicant(s) GOODING ET AL.	
	Examiner Kriellion A. Sanders	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 4, 6-9, 13-15 and 17-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 10-12, 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

Applicant states in the remarks filed 1/08/2007 that:

A restriction requirement was made on December 27, 2005 replacing an earlier restriction requirement of July 15, 2005. The Applicants made an election of Group I, claims 1-6, 10-17, 22 and 23 along with traverse. On January 6, 2006, In the Office Action of May 12, 2006, the Examiner acknowledged the traversal, made the Restriction final but failed to include claims 4, 6, 22 and 23 in her subsequent examination on the merits. The Applicants failed to notice this omission by the Examiner in their reply of July 10, 2006. As these claims (4, 6, 22 and 23) were originally designated as part of Group I, the Applicants respectfully request that these claims be considered along with 1-3, 5, 10-12 and 10-17.

Applicant is advised that in the election filed by applicant on 1/09/2006 applicant stated:

A previous restriction has been issued on July 15, 2005 with a response sent on October 12, 2005. The previous restriction requirement is withdrawn and replaced by a new one. The Applicants elect Group I, drawn to a paint and encompassing claims 1-6, 10-17 and 23. The Applicants are further requested to elect a single disclosed resin, a single disclosed coloring agent and a single disclosed binder resin. The Applicants are unclear as to why a species election of a binder resin is required as a binder resin element is not part of any claim. Nevertheless, Applicants have made an election as required. The Applicants elect a urea-aldehyde resin found in examples 1-3 on page 8 of the disclosure; a coloring agent of C.I. Pigment Red 254 shown in example 1 and a binder comprising copolymer of acrylic and methacrylic acid esters. See page 2, paragraph 3. When all of the single species components are elected, claims 1,2, 3, 5,10,11,12 and 16 encompass the combined elements.

Applicant is advised that applicant indicated the elected claims to be claims 1, 2, 3, 5, 10, 11, 12 and 16 as encompassing the combined elements. Therefore, claims 4, 6-9, 13-15 and 17-23 have been withdrawn from consideration.

1. Claims 4, 6-9, 13-15 and 17-23 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention or species, there being no allowable generic

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or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 1/09/06.

2. Newly submitted claim 24 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 24 is directed to a nonstructural laminate classified in class 428, subclass 411.1+.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 24 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. Applicant's election with traverse of the election of species requirement in the reply filed on 1/09/06 is acknowledged. The traversal is on the ground(s) that all of the elements of the non-elected claimed invention(s) are present in the elected claimed invention. This is not found persuasive because the inventions are related as product as process of use.

The requirement is still deemed proper and is therefore made FINAL.

4. This application contains claims 4, 6-9, 13-15 and 17-24 drawn to an invention nonelected with traverse. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 5, 10-12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 01277808.

The reference is relied upon for reasons of record. The European patent is directed to a process for preparing a pigment composition comprising a) mixing a pigment and a urea-aldehyde resin and/or a urea-ketone resin in a homogenizer or in the inlet (feeding) zone of the extruder, and b) extruding the mixture obtained in step a), and to a pigment composition obtainable by the process.

Suitable organic pigments for the patented pigment composition are selected from the group consisting of azo, azomethine, methine, anthraquinone, phthalocyanine, perinone, perylene, diketopyrrolopyrrole, thioindigo, iminoisoindoline, dioxazine, iminoisoindolinone, quinacridone, flavanthrone, indanthrone, anthrapyrimidine and quinophthalone pigments, or a mixture or solid solution thereof; especially an azo, dioxazine, diketopyrrolopyrrole, quinacridone, phthalocyanine, indanthrone or iminoisoindolinone pigment, or a mixture or solid solution thereof.

These pigments include the group consisting of C.I. Pigment Red 202, C.I. Pigment Red 122, C.I. Pigment Red 179, C.I. Pigment Red 170, C.I. Pigment Red 144, C.I. Pigment Red 177, C.I. Pigment Red 254, C.I. Pigment Red 255, C.I. Pigment Red 264, C.

The ground and sieved pigment compositions for solvent paints or spread coating have a maximum particle size below 500 μm , preferably the particle size of the pigment compositions lies within the range of 100 to 500 μm .

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The invention relates also to an organic or inorganic, high molecular weight or low molecular weight material, especially a high molecular weight organic material comprising the above-described compositions according to the invention in a effective amount ranging from 0.01 to 70% by weight, based on the organic or inorganic material.

See paragraph 0008, 0016, 0017, 0025, 0028 and 0033.

The properties of the pigments resulting from the prior art process, such as the ability of the pigment granules to dissolve, are inherently provided by the correlative properties of the components used therein. Because these properties cannot be separated from their components, they are necessarily present in the prior art compositions.

Response to Arguments

7. Applicant's arguments filed 1/08/07 have been fully considered but they are not persuasive. Applicant argues that the EP reference is directed to achieving consistent color attributable to a solvent based system as opposed to "a color burst" attributable to a water based system. Applicant concedes that the EP patent indicates that the polymers and colorant granules may be used in a water-based system. Applicant suggests that all of the working examples of the EP reference use are directed to a solvent-based system.

8. Applicant's arguments have not been found to be persuasive. The interpretation of the term, "consistency" as used by patentee is subjective. Even faux finishes may possess a consistency in their coloration, or in the patterns of their coloration. More particularly, the mere fact that the present water-based paints have been clearly suggested by the reference renders

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them obvious. Applicant takes issue with the examiner's opinion that the properties of the components of the EP reference are inherent. Applicant states:

As to the Examiner's inherency argument, that is "that pigments resulting from the prior art process such as the ability of the pigment granules to dissolve, are considered to be inherently provided by the correlative properties of the components used therein. Since these properties cannot be separated from their components they are necessarily present in the prior art compositions."

As the case law states *In re Spormann*, 363 F.2d 444, 150 USPQ 449, 452 (C.C.P.A. 1966):

[The] inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.

The Examiner states that EP'808 suggests the use of water based systems containing the presently claimed colorant granules. The Applicants point out that not one water-based system is exemplified. Thus EP'808 could not have known that water-based systems in combination with the colorant granules give a faux effect. As the Applicants point out in #1 above, the combination of the colorant granule in a solvent-based system does indeed give very different effects than the colorant granule in a water-based system. Therefore, as EP'808 had no recognition of the advantages and special effects of the water-based systems, the present claims cannot be obvious in light of EP'808 ("That which is unknown cannot be obvious).

9. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., faux effect) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The EP reference suggests all elements of the elected invention.

10. The patent refers to aqueous coating systems and suggests the use of the claimed urea-aldehyde pigment granules in a variety of coating compositions. Given the teachings of the

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reference, the ordinary practitioner in this art would have found it obvious to employ the urea-aldehyde pigment granules of the patented invention in water-based paints. See in particular, paragraph [0002] wherein patentee indicates that after being mixed into an aqueous or solvent-borne resin system, an organic pigment must be further dispersed prior to its final application in order to insure homogeneous dispersion in the resin system. Patentee's invention is directed towards eliminating the additional dispersion step. See paragraph [0008]. Patentee does not exclude the aqueous resin systems from the invention. Therefore, formulation of aqueous resin or coating systems utilizing the claimed urea-aldehyde pigments would have been obvious to the ordinary practitioner of this art at the time of applicant's invention.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kriellion A. Sanders whose telephone number is 571-272-1122. The examiner can normally be reached on Monday through Thursday 8:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kriellion A. Sanders
Primary Examiner
Art Unit 1714

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